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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,858	10/16/1998	BART ALAN MELTZER	OIN 1004-1	4734
22470	7590	12/21/2010		
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			ART UNIT	PAPER NUMBER
			2178	
			MAIL DATE	DELIVERY MODE
			12/21/2010	PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BART ALAN MELTZER, TERRY ALLEN, MATTHEW
DANIEL FUCHS, ROBERT JOHN GLUSHKO, and MURRAY
MALONEY

Appeal 2010-004354
Application 09/173,858¹
Technology Center 2100

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and THU A.
DANG, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed October 16, 1998. The real party in interest is Open
Invention Network, Inc.

² The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE”
(paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal from a twice rejection of claims 1 to 16³ and 61 to 74 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). An Oral hearing was held on September 22, 2010. This application, with the same claims, was appealed to the BPAI resulting in a Decision dated August 31, 2006 affirming the Examiner. A prior Rehearing of that Decision, Denied, was issued on May 21, 2007. Pursuant to a Request for Continued Examination (RCE) (7/23/07) and two subsequent rejections, including a Final Rejection of January 23, 2008, the case is before this Board again. Over 740 pages of Affidavits, Declarations and Exhibits have been now submitted to support a Declaration under Rule 131, which was previously found to be insufficient to antedate a reference.

We reverse.

Appellants' invention relates to the use of a machine readable specification of an interface between nodes in a network, including definitions of an input and an output document. The XML standard is cited as the preferred example of this invention (App. Br. 4, middle). In the words of Appellants:

Machine readable documents connect businesses with customers, suppliers and trading partners. The self defining electronic documents, such as XML based documents, can be easily understood amongst the partners. Definitions of these electronics business documents, called

³ See Ans. 5. Compare to App. Br. 1.

business interface definitions, are posted on the Internet, or otherwise communicated to members of the network. The business interface definitions tell potential trading partners the services the company offers and the documents to use when communicating with such services. Thus, a typical business interface definition allows a customer to place an order by submitting a purchase order or a supplier checks availability by downloading an inventory status report. Also, composition of the input and output documents, coupled with interpretation information in a common business library, programs the transaction in a way which closely parallels the way in which paper based businesses operate.

(Abstract, Spec. 113).

The following illustrates the claims on appeal:

Claim 1:

1. An interface for transactions among nodes in a network including a plurality of nodes which execute processes involved in the transactions, the interface being stored in a computer readable medium, comprising:

- a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

McKendrick, *Banks begin to play with XML*, Bank Technology News, Sept. 1998, at 6-7.

W3C, Extensible Markup Language (XML) 1.0: W3C recommendations 10-February-1998, <http://www.w3.org/TR/1998/REC-xml-19980210> (Feb. 10, 1998).

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 73 and 74 stand rejected under 35 U.S.C. § 112 paragraph 1 for failing to comply with enablement requirements. [rejection withdrawn, Ans. 25].

R2: Claims 73 and 74 stand rejected under 35 U.S.C. § 112 paragraph 2 for being unclear. [rejection withdrawn, Ans. 25].

R3: Claims 1 to 16 and 61 to 72 stand rejected under 35 U.S.C. § 103(a) for being obvious over McKendrick in view of W3C.

R4: Claims 73 and 74 stand rejected under 35 U.S.C. § 103(a) for being obvious over McKendrick in view of W3C.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue specifically turns on whether McKendrick's publication qualifies it as prior art, in view of the

Declaration submitted under Rule 131 (37 C.F.R. 1.131) and further whether McKendrick teaches the subject matter claimed, in view of W3C.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method and system for interchanging primarily business transactions among diverse computing platforms (Spec. 3, ll. 11 to 24). The invention uses a machine-readable specification for the transactions that includes interface documents with logical data structures and definitions of input and output documents for the transaction (Spec. 7, ll. 7 to 27). These definitions are key elements of the now-ubiquitous standard, XML; but the application was filed October 16, 1998, just at the birth of the XML (App. Br. 4, middle; W3C, page 1).
2. The McKendrick reference is a two-page article from Bank Technology News dated and copyright September 1998. It mentions that T. Rowe Price has upgraded its financial business products to Innovision Corp.'s latest Financial Server product, capable of moving XML based protocols (McKendrick, page 1). It further discusses the prospect for using XML for the next generation of Web documents (McKendrick, page 2). It states that XML may help customer service, as Web pages replace customer service centers, and quotes a Microsoft Corp. report. The quote of the report indicates that "And, because most of these business applications involve manipulation and transfer of data- such as purchase

orders, invoices, customer information and appointments XML will allow a rich array of business applications to be implemented.” (*Id.*).

3. W3C is the XML 1.0 recommendation for a standard for XML Extensible Markup Language, dated February 10, 1998. It discusses the full XML data standard, including storage units called entities, logical structures, document type declarations and so forth (W3C, 1 to 13).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The purpose of filing a 131 declaration is to demonstrate that the applicant’s date of invention is prior to the effective date of the reference cited in support of a rejection. *In re Eickmeyer*, 602 F.2d

974 (CCPA 1979). Where the reference cited in support of a rejection “substantially shows or describes but does not claim” the subject matter of the invention in question, § 131 allows the patent owner to overcome the reference by showing that the invention in question was reduced to practice prior to the filing date of the reference....

....

The Board relied on *Newkirk v. Lulejian*, 825 F.2d 1581 (Fed.Cir.1987), in holding that Asahi's 131 declaration was insufficient to prove reduction to practice because Asahi failed to show that the invention both existed and worked for its intended purpose. *Newkirk* states that “[p]roof of actual reduction to practice requires more than theoretical capability; it requires showing that the apparatus ... actually existed and worked for its intended purpose.” *Newkirk*, 825 F.2d at 1583.

In re Asahi/America, Inc., 68 F.3d 442, 445 (Fed. Cir. 1995)

ANALYSIS

*Arguments with respect to the rejection
of claims 1 to 16 and 61 to 74
under 35 U.S.C. § 103(a) [R3, R4]*

The Examiner has rejected the noted claims for being obvious over McKendrick in view of W3C. The arguments for both rejections will be considered together, as both rejections, on the same art, are subject to the same issues.

Appellants have two lines of argument: First, relying on a declaration submitted under 37 C.F.R. § 1.131, Appellants have attempted to “swear behind” the McKendrick reference (App. Br. 6 to 14). Second, Appellants

contend that the McKendrick reference does not provide substance that is sufficiently enabling by its disclosure or inherent teachings to support a rejection under 35 U.S.C. § 103(a). (App. Br. 14 to 20).

ISSUE 1: Is the Declaration under 37 C.F.R. 1.131 effective to remove the McKendrick reference from the prior art applicable to this invention?

In the prior appeal of this application, the Board held that the previously submitted evidence in support of reduction to practice was not sufficient “to provide a factual showing that the embodiment relied upon actually worked for its intended purpose.” (Response to Request for Rehearing, May 21, 2007, page 2, bottom). As mentioned above, Appellants have, in this RCE of the application, provided over 740 pages of materials in support of the 131 Declaration.

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

The Examiner has reviewed the documentation and has found it insufficient to remove the McKendrick reference for the following reasons.

First, the Examiner finds that the evidence only includes “program coding dated in 1997 and 1998 and there is no statement along with the dates verifying that these programs are tested and worked successfully.” (Ans. 19,

top). In response Appellants describe the evidence submitted with respect to preparations for a demonstration to Ingram on January 21, 1998 (Reply Br. 3, middle; Reply Br. 4). In reading the current '131 Declaration, we find indications by the declarants that “we had sufficiently worked with imdesc.xml to recognize and understand that it would serve its intended purpose of defining a document-based transaction interface that can include a series of related document exchanges.” (Declaration, ¶ 16). On review of the related code, we find input and output document descriptions and other elements of claim 1 (Declaration, ¶ 14). In addition, Appellants have submitted arguments and evidence supporting the elements of each of the claims on appeal (App. Br. 9 to 14 and referenced exhibits.) We thus disagree with the Examiner and find that the preponderance of the evidence indicates that the programs worked as intended.

Reduction to practice is a question of law. *Hybritech, Inc. v Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986). “Proof of actual reduction to practice requires more than theoretical capability; it requires showing that the apparatus ... actually existed and worked for its intended purpose.” *Newkirk v. Lulejian*, 825 F. 2d 1581, 1583 (Fed. Cir. 1987).

We thus conclude that the standard for reduction to practice has been satisfied.

The Examiner next argues that one of the inventors, Terry Allen, stated in an Exhibit dated December 5, 1997, that the Specification was still unstable, and thus “the submitted evidence provided in the Exhibits is not sufficient for showing a complete product successfully working with testing

and proving reduc[tion] to practice of the invention before the effective date of McKendrick.” (Ans. 19, bottom to Ans. 20, top).

Appellants have addressed this concern of the Examiner about the instability noted by Mr. Allen in significant detail. (Reply Br. 5 to 7). We find that they have established that the instability mentioned was not of XML itself, or the Common Business Language⁴ (CBL) of Exhibit C (R424; Reply Br. 5, middle). Instead, the instability was found to be with the XML linking specification, which was still a standard under development at the time of the quote. The complete quote is expressed by Appellants (Reply Br. 5, bottom) and exhibits are presented establishing that the XLink requirements, not necessary for the CBL interface of the claim, were yet to be finalized (Reply Br. 6, with footnotes 5 to 7). The Examiner’s skepticism concerning fixing the instability of the software within a month of the quoted Allen language is thus addressed. We find the evidence in the record convincing that the input and output definitions and other elements required by the claims were present in the imdesc.xml program, and that the program was found to be operational before February, 1998, the date of the McKendrick references.

The Examiner further expresses concern that the submitted evidence does not demonstrate the existence of “a complete product that is guaranteed that it worked with testing” before the McKendrick reference’s effective date (Ans. 20, bottom). The Examiner has not, in this comment, expressed the test that is accepted by the case law. The law requires that “proof of actual reduction to practice requires ... showing that the apparatus ... actually existed and worked for its intended purpose.” *Newkirk v. Lulejian*,

⁴ Sometimes “common business library” (App. Br. 4, bottom).

cited above (quoted in *In re Asahi/America, Inc.* 68 F.3d 442, 444 (Fed Cir. 1995)). As mentioned above, we found sufficient support for that conclusion in the 131 Declaration, paragraphs 16 and 17, and related Exhibits D, E, H and I.

Regulation 37 C.F.R. § 1.131 as quoted above requires Appellants “to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.” We see no arguments concerning the date of conception of the instant invention. We have studied the declarations and exhibits of record, and we agree with Appellants that the record supports a date of reduction to practice of the claimed invention to be prior to the effective date of the McKendrick reference. The McKendrick reference thus cannot be used to support a conclusion of obviousness under 35 U.S.C. § 103(a).

ISSUE 2: Is the McKendrick reference sufficiently enabling to teach or suggest to one of ordinary skill in the art the elements of this invention?

As the McKendrick reference has been removed from the applicable prior art, this issue is now rendered moot.

The removal of the McKendrick reference negates the basis for the rejection of all of the appealed claims under 35 U.S.C. § 103(a). We find the Examiner has erred in maintaining rejections R3 and R4 under that statute.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have shown that the Examiner erred in rejecting claims 1 to 16 and 61 to 74.

DECISION

We reverse the Examiner's rejections R3 and R4 of claims 1 to 16 and 61 to 74.

REVERSED

peb

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